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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,661	07/16/2003	Richard M. Ehrlich	PANA-01046USF	9576
23910	7590	10/18/2005	EXAMINER	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			SNIEZEK, ANDREW L	
			ART UNIT	PAPER NUMBER
			2651	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

✓ 10/620,661

Applicant(s)

EHRlich, RICHARD M.

Examiner

Andrew L. Sniezek

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-20 is/are allowed.
- 6) ☒ Claim(s) 1,2 and 21-24 is/are rejected.
- 7) ☒ Claim(s) 3-7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date 4/25/05, 7/12/05, 9/19/05, 1-13-05

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statements filed 4/25/05, 7/12/05 and 9/19/05 have been considered.

### ***Terminal Disclaimer***

2. The terminal disclaimer filed on 4/25/05 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on application 10/621,048 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 21 –23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10 and 15 of copending Application No. 10/690,971. Although the conflicting claims are not identical, they are not patentably distinct from each other because each is directed to searching

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for a servo address mark pattern using plural (two) different parameters. Note a nominal frequency is disclosed as one type of parameter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 21-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10 and 15 of copending Application No. 10/620,818. Although the conflicting claims are not identical, they are not patentably distinct from each other because each is directed to the use of plural (two) distinct parameters to search for a servo address mark pattern. Note a nominal frequency is disclosed as a parameter. Also, although the present application is written using method limitations instead of structural limitations, such a difference is deemed obvious since the body of the claims correspond to one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Tuttle et al.

Re claims 1-2: Tuttle et al. teaches an arrangement and corresponding method that searches for a SAM pattern at a first nominal frequency when the SAM is in a first zone and searches for a SAM pattern at a second nominal frequency when the pattern is in a second zone. See figures 3 and 7 along with column 15, lines 42-54, column 11, lines 34-46 and lines 63-67, column 12, lines 44-67 which teach the use of shadow registers which store control values based on zones. These values can include sampling frequencies in which the servo mark detector (A126) operates. See column 21 lines 42-52.

8. Claims 21, 23, 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Aziz (US 20040190646A1).

Re claim 21: Aziz teaches a method and apparatus that simultaneously searches for servo address marks (see figure 6) elements (603a) and (603b) within a servo wedge, i.e. servo sector using plural different frequencies (operation of 508)

Re claims 23, 24: Note coefficients of the equalizer (508) are variable to boost high frequencies, which are then sampled.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aziz in view of Tuttle et al.

The teaching of Aziz is discussed above and incorporated herein. Claim 22 additionally sets forth a servo wedge that is zone recorded, which although not taught by Aziz is well known as taught by Tuttle et al. (see for example column 4, lines 55-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate zone recording as taught by Tuttle et al. in the arrangement of Aziz so as to provide an arrangement with increased storage density.

***Allowable Subject Matter***

11. Claims 8-20 are allowed.

12. Claims 3-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter: The claimed method as set forth in claim 8 having a zone bit recording disk that searches for SAM patterns in first and second zones using first and second frequencies, characterizes the detections as a good SAM or a bad SAM and then performs additional servo functions if the detection results in a good SAM is neither taught by nor an obvious variation of the art of record.

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The claimed method as set forth in claim 1 that additionally selects one detection of the SAM pattern if found at both nominal frequencies in the same servo wedge as set forth in claim 4 is neither taught by nor an obvious variation of the art of record.

The claimed method of claim 1 that additionally "simultaneously" searches in a manner as set forth in claim 3 is neither taught by nor an obvious variation of the art of record.

The claimed method of claim 1 that additionally determines which one of the two zones in a manner as set forth in claims 6 and 7 is neither taught by nor an obvious variation of the art of record.

#### ***Response to Arguments***

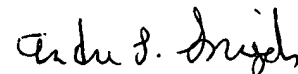
14. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L. Snizek whose telephone number is 571-272-7563. The examiner can normally be reached on Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Andrew L. Sniezek  
Primary Examiner  
Art Unit 2651

A.L.S.  
10/13/05